

REMARKS

I. Response to Restriction Requirement

The Action states that restriction to one of the following inventions is required under 35 U.S.C. § 121:

- Invention I: Claims 1-12, 56-57;
- Invention II: Claims 13-26;
- Invention III: Claims 27-38;
- Invention IV: Claims 39-52;
- Invention V: Claims 53-55, 58-64; or
- Invention VI: Claims 65-78.

In response to the above restriction requirement, Applicants have cancelled Claims 13-26, 39-52, and 65-78. Moreover, for purposes of providing a complete reply to the Action, **Applicants elect Invention I (Claims 1-12, 56-57) for prosecution on the merits.** Applicants, however, make this election with traverse in that Applicants respectfully assert that it is proper for Claims 1-12, 27-38, and 53-64 to be examined together for at least the following reasons.

The Action states that restriction is required between Invention I (Claims 1-12 and 56-57) and Invention III (Claims 27-38) pursuant to MPEP § 806.05(e) as the process of Invention I can allegedly be performed by a materially different apparatus, namely "a computer program product for selling regulated goods over a computer network." (Action at 4). Applicants respectfully submit, however, that the allegedly materially different apparatus is encompassed within the scope of the claims of Invention III. In particular, the claims of Invention III are drafted pursuant to 35 U.S.C. § 112, ¶ 6 in means-plus-function form. Such claims cover, among other things, all means for carrying out the recited function disclosed in the specification and structural equivalents thereto. As evidenced, for example, by Claims 53-64, the specification as originally filed disclosed implementing the systems of Claims 27-38 as computer program products. As such, the computer program product identified in the Action as comprising a "materially different apparatus" is actually encompassed within the scope of the claims of Invention III. As such, restriction between Inventions I and III is not proper under MPEP § 806.05(e), and Applicants therefore respectfully request withdrawal of the restriction requirement between Inventions I and III.

Applicants likewise respectfully submit that restriction between Inventions I and V (Claims 53-55 and 58-64) is not warranted. Here, the Action states that restriction between Inventions I and V is required under MPEP § 806.05(e) because the processes of Invention I may be carried out by another, materially different apparatus, such as by "a system for selling regulated goods over a computer network." (Action at 5). Applicants respectfully submit, however, that given the almost word-for-word correspondence between the claims of Inventions I and V, the "system" suggested in the Action is not materially different from the computer program products of Invention V. Moreover, given the almost word-for-word correspondence between the claims of Inventions I and V, and the fact that it is already necessary for the examiner to perform a search directed to the system claims of Invention III (for the reasons discussed above), which encompass computer program products, there will be no additional burden on the examiner to perform a search directed to the claims of each of Inventions I, III and V. Pursuant to MPEP § 803, Restriction between allegedly patentably distinct inventions may only be made if "there would be a serious burden on the examiner if restriction is not required. Applicants respectfully submit that in light of the search that will be necessary for the claims of Inventions I and III, there will not be a serious burden on the examiner to also search and examine the claims of Invention V. This is particularly true here in light of newly added dependent Claim 79, which specifically recites that various components of the system of Claim 27 are implemented as computer readable program code.

Applicants also respectfully traverse the restriction requirement between Inventions I, III and V because it is based on the argument that Inventions I, III and V are distinct. Pursuant to MPEP § 802.01, for two inventions to be distinct, "at least one invention [must be] PATENTABLE (novel and nonobvious) OVER THE OTHER." (Emphasis in original). Here, Applicants respectfully submit that in light of the almost word-for-word correspondence between the claims of Inventions I, III and V – which differ only in whether the invention is claimed as a method, system or computer program product – the inventions of the independent Claims 1, 27 and 53 are not patentable over each other. Accordingly, MPEP § 802.01 provides a separate and distinct basis for withdrawal of the restriction requirement between Inventions I, III and V.

Finally, the Examiner's attention is also respectfully directed to pages 14-15 of Applicants' specification, which states:

The present invention is described below with reference to block diagram and flowchart illustrations of methods, apparatus (systems) and computer program products according to embodiments of the invention. It will be understood that each block of the block diagrams and/or flowchart illustrations, and combinations of blocks, can be implemented by computer program instructions. These computer program instructions may be provided to a processor of a general purpose computer, special purpose computer, or other programmable data processing apparatus to produce a machine, such that the instructions, which execute via the processor of the computer or other programmable data processing apparatus, create structures for implementing the functions specified in the block diagram and/or flowchart block or blocks. Each block, and combinations of blocks, can be implemented by servers which perform the specified functions or steps, or combinations of special purpose hardware and computer instructions.

These computer program instructions may also be stored in a computer-readable memory that can direct a computer or other programmable data processing apparatus to function in a particular manner, such that the instructions stored in the computer-readable memory produce an article of manufacture including instructions which implement the function specified in the block diagram and/or flowchart block or blocks.

The computer program instructions may also be loaded onto a computer or other programmable data processing apparatus to cause a series of operational steps to be performed on the computer or other programmable apparatus to produce a computer implemented process or method such that the instructions which execute on the computer or other programmable apparatus provide steps for implementing the functions specified in the block diagram and/or flowchart block or blocks.
(Emphasis added).

What the above passages mean is that the blocks in the flowchart illustrations of Figs. 2-9 apply to the methods of Claims 1-12, systems (Claims 27-38) for implementing the methods of Claim 1-12, and computer program products (Claims 53-64) containing operational steps for implementing the methods of Claims 1-12 on a computer or other programmable apparatus. Accordingly, Claims 1-12, 56-57 should be examined along with the corresponding system and computer program product claims (Claims 27-38 and 53-64).

II. New Claims 79-80

Applicants have added new Claims 79 and 80 to the present application. Claim 79 depends from Claim 27, and is directed to Invention III. Claim 80 depends from Claim 1, and is directed to Invention I. Consideration and examination of these new claims is also respectfully requested.

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Filed: June 23, 2003
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III. Conclusion

For the above reasons, it is respectfully submitted that Claims 1-12, 27-38 and 53-64 and 79-80 are in condition for substantive examination, and examination of these claims is respectfully requested.

Respectfully submitted,

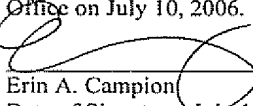


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Date of Signature: July 10, 2006